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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue of

Letters Patent 5,568,207

Richard CHAO

Serial No.: 09/182,862

Filed: October 21, 1998

For: AUXILIARY LENSES FOR EYEGLASSES

Examiner: H. Mai

Group Art Unit: 2873

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Commissioner of Patents
Washington, D.C. 20231

AMENDMENT PURSUANT TO 37 C.F.R. § 1.116

SIR:

Kindly amend the above-identified application in response to the May 22, 2001 Office

Action and the June 18, 2001 Interview as follows:

IN THE CLAIMS:

1. **(Five Times Amended)** An eyeglass device comprising:

a primary spectacle frame for supporting primary lenses therein, said primary spectacle frame including two side portions each having an extension extended therefrom for pivotally coupling a leg means thereto, said primary spectacle frame including two rear and side portions each having a projection secured thereto, said primary spectacle frame including an upper side portion,

a pair of first magnetic members secured in said projections respectively,

an auxiliary spectacle frame for supporting auxiliary lenses therein, said auxiliary spectacle frame including two side portions each having an arm extended therefrom for

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extending over and for engaging with said upper side portion of said primary spectacle frame,
and

a pair of second magnetic members secured to said arms respectively for engaging with
said first magnetic members of said primary spectacle frame so as to secure said auxiliary
spectacle frame to said primary spectacle frame,

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said arms being engaged with and supported on said upper side portion of said primary
spectacle frame so as to allow said auxiliary spectacle frame to be stably supported on said
primary spectacle frame and so as to prevent said auxiliary spectacle frame from moving
downward relative to said primary spectacle frame and so as to prevent said auxiliary spectacle
frame from being disengaged from said primary spectacle frame.

4.

12. (Twice Amended) An eyeglass device comprising:

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a primary spectacle frame for supporting primary lenses therein with the lenses defining a
vertical plane, the primary spectacle frame including two side portion extensions extended
therefrom for pivotally coupling a leg thereto and a first magnet having a horizontal surface and
secured to said side portion extensions of the primary spectacle frame, and

an auxiliary spectacle frame for supporting auxiliary lenses therein, and for disposing in
front of the primary spectacle frame, the auxiliary spectacle frame including two auxiliary side
portions, the auxiliary spectacle frame including two second magnets, each secured to one of the
auxiliary side portions for respectively engaging the horizontal surface of one of the first
magnets so as to secure the auxiliary spectacle frame to the primary spectacle frame.

6.

36. (Twice Amended) An eyeglass device comprising:

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a primary spectacle frame for supporting primary lenses therein;

the primary spectacle frame including two side portion extensions extended therefrom for pivotally coupling a leg thereto; and

the primary spectacle frame including two first magnetic members respectively having a horizontal surface and being secured to one of the side portions extensions of the primary spectacle frame; and

an auxiliary spectacle frame for supporting auxiliary lenses therein, and for disposing in front of the primary spectacle frame, the auxiliary spectacle frame including two auxiliary side portions, wherein the auxiliary spectacle frame further includes two second magnetic members each secured to one of the auxiliary side portions and having a horizontal surface for coupling a corresponding horizontal surface of one of the first magnetic members so as to secure the auxiliary spectacle frame to the primary spectacle frame.

11. 40. (Once Amended) An eyeglass device as recited in Claim 36 wherein the auxiliary side portions are respectively supported on a corresponding extension and the first magnetic members are not in contact with the second magnetic members.

10. 41. (Once Amended) An eyeglass device as recited in Claim 39 wherein the auxiliary side portions are respectively supported on a corresponding extension and the first magnetic members are not in contact with the second magnetic members.

14. 68. (Once Amended) An eyeglass device comprising:

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a primary spectacle frame for supporting primary lenses therein, said primary spectacle frame including two side portion extensions extended therefrom for pivotally coupling a leg, each of said extensions also including an outer side, an inner side, and a top side with a projection secured to said inner side, each of said projections respectively securing a first magnetic member, and

an auxiliary spectacle frame for supporting auxiliary lenses therein, said auxiliary spectacle frame including two side portions each having an arm extended therefrom, said auxiliary spectacle frame further including a pair of second magnetic members secured to said arms respectively for engaging said first magnetic members of said primary spectacle, each of said arms adapted to extend over one of said top sides.

18.

71. (Once Amended) An eyeglass device comprising:

a primary spectacle frame having two side portion extensions extending rearwardly therefrom having a top side and a rear side with a first magnetic member secured thereto, and

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an auxiliary spectacle frame including two arms for extending over a corresponding top side of said extensions, said arms respectively containing second magnetic members for cooperation with said first magnetic members and downwardly extended end portions for hooking said auxiliary spectacle frame to said primary spectacle frame, said arms and said first and second magnetic members supporting said auxiliary spectacle frame on said primary spectacle frame.

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73. (Once Amended) An eyeglass device comprising:

a primary spectacle frame for supporting primary lenses therein having two side portion

extensions having a top side and a rear side with a first magnetic member secured to said rear side, and

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an auxiliary spectacle frame including two arms for extending over and engaging a corresponding top side of said extensions, said arms respectively containing downwardly extended second magnetic members for hooking said auxiliary spectacle frame to said primary spectacle frame, said arms and said first and second magnetic members cooperating to support said auxiliary spectacle frame on said primary spectacle frame.

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75. (Once Amended) An eyeglass device comprising:

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a primary spectacle frame for supporting primary lenses therein and having two side portion extensions extending rearwardly therefrom and having a front side, a rear side, a top side, and a rear end, each of said rear ends pivotally coupling a leg configured to conform to a user at a distal end thereof, each of said extensions of said primary spectacle frame further having a projection attached to each of said rear sides, and a pair of first magnetic members respectively secured in said projections, said first magnetic members capable of engaging second magnetic members of an auxiliary spectacle frame so that lenses of an auxiliary spectacle frame are located in front of said primary lenses.

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78. (Once Amended) An eyeglass device comprising:

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a primary spectacle frame having two side portion extensions extending therefrom and adapted to pivotally couple a leg thereto, said extensions each having a front side, a rear side, a top side and a projection extending from said rear side, each of said projections securing a first magnetic member, and

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an auxiliary spectacle frame including two side portions each having an arm extended therefrom for extending over said top side, said arms containing corresponding second magnetic members, said arms with said second magnetic members engaging said first magnetic members thereby securing said auxiliary frame to said primary spectacle frame to prevent said auxiliary spectacle frame from moving downward relative to and/or disengaging from said primary spectacle frame.

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86. (Once Amended) An eyeglass device comprising:

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a primary spectacle frame having two side portion extensions extending rearwardly therefrom with a top side and a rear side with a first magnetic member secured thereto, and
an auxiliary spectacle frame including two arms for extending over a corresponding top side of said extensions, said arms respectively containing second magnetic members for cooperation with said first magnetic members and downwardly extended end portions for hooking said auxiliary spectacle frame to said primary spectacle frame, said arms and said first and second magnetic members supporting said auxiliary spectacle frame on said primary spectacle frame, wherein at least one of said first magnetic members and said second magnetic members are magnets.

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86. (Once Amended) An eyeglass device comprising:

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a primary spectacle frame having two side portion extensions with a front side, a rear side and a first magnetic member
an auxiliary spectacle frame including two side portions each having an arm extended therefrom, each of said arms containing a second magnetic member, said arms extending across a

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respective extension from said front side to said rear side so that said first and second magnetic members engage one another whereby said auxiliary spectacle frame is supported by said primary spectacle frame.

REMARKS

Upon entry of the above claims 1, 12, 36, 40, 41, 68, 71, 73, 75, 78, 86 and 89 will have been amended. Claims 36, 40, 41 and 73 have been amended in response to the Examiner's Office Action. Allowed Claims 12, 68, 71, 73, 75, 78, 86 and 89 have been amended for claim consistency and more concise language, e.g., "side portion extensions" instead of "side portions, each side portion having an extension." Thus the requested changes to allowed claims 12, 68, 71, 75, 78, 86 and 89 are not made for the purpose of obtaining patentability since those already been indicated to be in condition for allowance. Allowed Claim 75 has also been amended to describe the positioning of an auxiliary frame lens which may be used with the primary frame, but is not recited in Claim 75. Thus the change to Claim 75 is not made for the purpose of obtaining patentability of Claim 75. Claims 1-3, 12, 28, 36-41 and 67-89 are pending in the reissue application. Claims 1-3, 12, 28, 67-72 and 74-89 have been allowed.

Claim 1 has been amended and is now identical to patent claim 1 in all regards. Claim 36 has been amended by reciting that the first and second magnetic members respectively have horizontal surfaces which may be coupled to one another, in a manner similar to that of allowed application claim 12. Claims 40 and 41 have also been amended to recite that the auxiliary side portions are also "supported on a corresponding extension" of the primary spectacle frame. Claim 73 has been amended in accordance with the Examiner's suggestion to provide clear antecedent basis for the auxiliary spectacle frame originally recited in the claim. Accordingly,

antecedent basis for the auxiliary spectacle frame originally recited in the claim. Accordingly, claim 73 should be in condition for allowance. No new matter has been introduced by this Amendment. No new issues have been raised that require further consideration or search. Entry and reconsideration are respectfully requested.

I- OFFER TO SURRENDER/CONSENT

On March 29, 2001, applicant filed an Offer to Surrender and Consent by Asahi Kogaka Kogyo Kabushiki Kaisha (A.K.A. Asahi Optical Co., Ltd.), who is the assignee of the entire right, title, and interest of a one-half part of United States Patent No. 5,568,207. However, the May Office Action fails to acknowledge either of these documents. Correction of the record to reflect receipt of these documents is respectfully requested.

II- RELATED LITIGATION

Applicant wishes to update the status of CV-99-1923, Aspex Eyewear, Inc., v. Revolution Eyewear, Inc. On June 5, 2001, Judge Baird issued an order indicating that Defendant Revolution Eyewear's challenge of the Chao '207 patent's validity was unsuccessful. Thus, the Chao '207 patent remains valid and enforceable. A copy of Judge Baird's Order is attached.

III- JUNE 18, 2001 INTERVIEW

Applicant would like to thank Primary Examiner Mai for the courtesy extended his representative during the Interview conducted on June 18, 2001. The above Amendment and following remarks represent the substance of the interview.

**IV- RESPONSES TO REJECTIONS/OBJECTIONS RAISED
IN THE MAY 2001 OFFICE ACTION AND DISCUSSED
DURING THE JUNE 18, 2001 INTERVIEW**

1. APPLICANT'S REISSUE OATH - 35 USC § 251

In the May 22, 2001 Office Action, the Examiner in ¶ 2 agreed that applicant's "supplemental declaration [filed on March 29, 2001] is in complete compliance with the reissue rules as argued," but objects to applicant's supplemental reissue declaration because the "errors" identified in ¶¶ VI and VIII are no longer relied upon, and requests that these be "removed." During the June 18, 2001 Interview, the Examiner's attention was directed to the Manual for Patent Examining Procedure, section 1414(II)¶(2)(Rev. 1, Feb. 2000), which states "Applicant need only specify...one of the errors upon which the reissue is based," and in ¶(3),

Where more than one error is specified in the oath/declaration and some of the designated "errors" are found to not be errors under 35 U.S.C. 251, any remaining error which is an error under 35 U.S.C. 251 will still support the reissue.

Accordingly, during the June 18, 2001 Interview, the Examiner withdrew the improper objection to the declaration set forth in ¶ 2 of the May 22, 2001 Office Action.

2. RESPONSE TO REJECTION UNDER 35 USC § 112, 2ND ¶

Claims 36, 40, 41 and 73 have been rejected under 35 USC § 112, 2nd ¶. Applicant respectfully submits that in view of the June 18, 2001 Interview and Applicant's changes to claims 36, 40, 41 and 73 above, the 35 USC § 112, 2nd ¶ rejection set forth in the May 22, 2001 Office Action is no longer applicable and should be withdrawn.

Claims 36-41 have been rejected under 35 USC § 102 (e) as being anticipated by U.S. patent No. 5,642,177 (Nishioka). Applicant respectfully submits that the Nishioka patent does not teach or suggest the invention of now amended claim 36. As previously argued, Nishioka shows magnetic engagement along a vertical plane. A clarifying amendment has been made to claim to more clearly distinguish the horizontal attraction between the first and second magnetic members. Accordingly, in view of the above Amendment to claim 36, and Examiner Mai's acknowledgement that the amendment to claim 36 overcomes the rejection based on the Nishioka patent, it is respectfully submitted that this improper rejection should be withdrawn.

V- OFFER TO SURRENDER

In accordance with Applicant's offer to surrender the original Letters Patent, Applicant submits in lieu of the Letters Patent a "Declaration as To Loss of Patent" in compliance with the USPTO rules. (M.P.E.P. § 1416).

VI- CONCLUSION:

Claims 1-3, 12, 28, 67-72 and 74-89 have been allowed. Examiner Mai has also indicated that in view of Applicant's proposed changes to claims 36, 40, 41 and 73, incorporated in the above Amendment, those claims are also in condition for allowance. Accordingly, claims 1-3, 12, 28, 36-41 and 67-89 are in condition for allowance and that action is earnestly solicited.

VII- AUTHORIZATIONS:

No petition or fee is necessary.

The Commissioner is also hereby authorized to charge any additional fees which may be required for timely consideration of this Amendment under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment to Deposit Account No. 13-4500, Order No. 4216-4000.

Respectfully submitted,

Date: June 21, 2001

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